



PATENT
Attorney Docket No. 07781.0207-00
SAP Reference No. 2002P00043WOUS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Georg PODHAJSKY et al.)	Group Art Unit: 3684
)	
Application No.: 10/525,732)	Examiner: Nancy T. MEHTA
)	
Filed: February 3, 2006)	Confirmation No.: 8294
)	
For: BUSINESS APPLICATION)	Mail Stop AF
GENERATION SYSTEM)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the rejections in the Final Office Action ("Office Action") mailed August 17, 2009 maintained in the Advisory Action of October 17, 2009, the period for response to which extends through November 17, 2009. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005.

A pre-appeal brief review of the rejection set forth in the Final Office Action is proper because: (1) the application has been at least twice rejected; (2) Applicants have concurrently filed a Notice of Appeal (prior to filing an Appeal Brief); and (3) this Pre-Appeal Brief Request for Review is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. See Official Gazette Notice, July 12, 2005.

REMARKS

Claims 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37 are pending and under current examination. In the Advisory Action mailed October 27, 2009, the Examiner maintained the rejection of claims 1, 14, 18, 20, 33 and 37 under 35 U.S.C. § 112, second paragraph; rejected claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37 under 35 U.S.C. § 101; and rejected claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37 under 35 U.S.C. § 103(a), as being allegedly unpatentable over U.S. Patent Application Publication No. 2002/0092004 to Lee, et al. ("*Lee*").

Rejection of claims under 35 U.S.C. § 112, second paragraph

Applicants respectfully traverse the rejection of claims 1, 14, 18, 20, 33, and 37 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as the invention. The Advisory Action alleges that the claimed limitation "'said business process application' ... leads to antecedent basis problem," as recited in claim 1. Advisory Action, p. 2. This is incorrect. Claim 1 recites, among others, "said customized business process application," which is clearly referred to "a customized business process application," as further recited in claim 1. As such, Applicants submit that claim 1 is definite under 35 U.S.C. § 112, second paragraph. Independent claims 14, 18, 20, 33, and 37, although differing in scope from independent claim 1, recite similar elements and are therefore allowable for at least reasons similar to those set forth above for independent claim 1.

Rejection of claims under 35 U.S.C. § 101

Applicants respectfully traverse the rejection of claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37 under 35 U.S.C. § 101 as being directed to non-statutory

subject matter. The Advisory Action alleges that “applicant’s amendments ... do[] not show clearly that **each step** in the method claims is bei[ng] carried by computer” (emphasis added). Advisory Action, p.2. Applicants note that “each step” in a statutory method claim need not be carried out by a computer. According to In re Bilski, “a claimed process is purely patent-eligible under §101 if (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” In re Bilski, 545 F.3d 943, at 954. Independent claim 1 recites “a central processing unit,” which includes statutory subject matter under In re Bilski. Independent claim 14 recites “steps ... performed by a computer,” which includes statutory subject matter under In re Bilski. Independent claim 18 recites “steps ... performed by a processor,” which includes statutory subject matter under In re Bilski. Independent claim 20 recites “a central processing unit,” which includes statutory subject matter under In re Bilski. Independent claim 33 recites “steps ..., executed by a computer,” which includes statutory subject matter under In re Bilski. Independent claim 37 recites “performed by a processor,” which includes statutory subject matter under In re Bilski. Accordingly, these independent claims, as well as claims 3-9, 12, 13, 17, 22-28, 30-32, and 36 that depend from the independent claims, are statutory, and the rejection of these claims should be withdrawn.

Rejection of claims under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37 under 35 U.S.C. § 103(a), as being allegedly unpatentable over *Lee*. A *prima facie* case of obviousness has not been established with respect to any of these claims.

Independent claim 1, recites “[a] passer element [that] processes ... data for input to said generating element.” Further, independent claim 1 recites that the processing includes “interpreting ... said set of customized meta data” and “translating said ... data into customized business process data for input into said generating element.” *Lee* fails to disclose or suggest at least these recited elements of independent claim 1.

In *Lee*, “the design program 26 [is used] to create a system design for a new software application.” Paragraph [0035]. Specifically, in *Lee*, “the design program 26 prompts the designer for elements of the system design and stores those elements as a design database file 34 which is stored in the design database 30.” *Id.* Further, “the design database file 34 created by the design program 26 **is passed to the generator program 28** where it is reformatted as an extensible markup language (XML) meta document” (emphasis added). *Id.* That is, in *Lee*, generator program 28 merely receives processed information from design program 26. The generator program 28 of *Lee*, however, does not send any information to design program 26. As such, contrary to the Examiner’s allegation, the generator program 28 of *Lee* is not analogous to the claimed “passer element,” because it does not at least “process[] ... **data for input to design program 26**” (emphasis added).

Additionally, as mentioned above, generator program 28 of *Lee* does not send, but only receives, information from the design program 26. Thus, generator program 28 of *Lee* does not constitute the claimed “passer element,” which further “interpret[es] ... said set of customized meta data” and “translat[es] said ... data into customized business process data **for input into said generating element,**” as recited in claim 1

(emphasis added). Therefore, *Lee* does not teach or even suggest all of the elements of claim 1 for at least the above reasons.

In view of the foregoing, the Office Action has neither properly determined the scope and content of the prior art, nor ascertained the differences between the claimed subject matter and the prior art. For at least this reason, no *prima facie* case of obviousness has been established. The rejection of independent claim 1 under 35 U.S.C. § 103(a), as being obvious over *Lee*, is thus improper and should be withdrawn.

Further, independent claims 14, 18, 20, 33, 37, although differing in scope from independent claim 1, recite similar elements and are therefore allowable for at least reasons similar to those set forth above for independent claim 1. Claims 3-9, 12, 13, 17, 22-28, 30-32, and 36 depend from the independent claims.

CONCLUSION

In view of the foregoing, Applicants respectfully request that the rejection be withdrawn and the claims allowed.

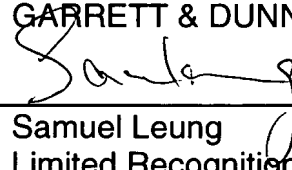
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 3, 2009

By: _____


Samuel Leung
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(202) 408-4000